

**REMARKS**

Claims 1-26 were pending in this application.

Claims 1-26 have been rejected.

Claims 1-26 have been amended as shown above.

Claims 1-26 remain pending in this application.

Reconsideration and full allowance of Claims 1-26 are respectfully requested.

**I. OBJECTIONS TO CLAIMS**

The Office Action objects to Claim 15 because the phrase “second length” is indefinite. The Applicants have amended Claim 15 to recite a “second portion” rather than a “second length.” The Applicants respectfully submit that Claim 15 is definite. In particular, the Applicants respectfully note that Claim 15 as amended recites both a “first portion” and a “second portion.” As a result, there is no ambiguity in the use of the phrase “second portion” in Claim 15.

The Office Action also objects to Claim 26 because of an improper dependency. The Applicants have amended Claim 26 to correct this informality.

Accordingly, the Applicants respectfully request withdrawal of the objections to the claims.

**II. REJECTION UNDER 35 U.S.C. § 101**

The Office Action rejects Claims 21 and 22 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Office Action asserts that Claims 21 and 22 recite a “signal” that is “non-functional descriptive matter per se.”

The Applicants have amended Claim 21 to recite a “transmission medium” comprising a “modeled modified signal.” The Applicants have also amended Claim 22 to recite a “storage medium” comprising a “modeled modified signal received over a transmission medium.”

The Applicants respectfully submit that Claims 21 and 22 as amended do not recite merely a “signal” and do not recite “non-functional descriptive matter per se.”

Accordingly, the Applicants respectfully request withdrawal of the § 101 rejection.

### **III. REJECTION UNDER 35 U.S.C. § 102**

The Office Action rejects Claims 1, 3, 5-12, 18, and 25 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,266,644 to Levine (“*Levine*”). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

*Levine* recites an encoding system that includes a transient detector capable of dividing an audio source into transient regions and non-transient regions. (*Abstract*). The transient regions are encoded using one technique, and the non-transient regions are encoded using different techniques depending on whether the regions exceed a threshold frequency. (*Col. 5, Lines 21-29*). The system

also includes a transient mover, which moves transient regions without altering the regions. (*Col. 24, Lines 21-40*).

Claims 1 and 25 recite that the “location” of a transient is modified so that the transient “occurs at a specified location on a predetermined time scale.” *Levine* fails to anticipate these elements of Claims 1 and 25. In particular, *Levine* only recites that a transient region is “moved to another position in time” or that transients regions are “moved unaltered to their new positions.” (*Col. 24, Lines 38-40 and 48-51*). *Levine* lacks any mention of moving one of the transient regions so that the transient region occurs at a “specified location” on a “predetermined time scale.” As a result, *Levine* fails to anticipate all elements of Claims 1 and 25.

For these reasons, *Levine* fails to anticipate the Applicants’ invention as recited in Claims 1 and 25 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 1, 3, 5-12, 18, and 25.

#### IV. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claim 2 under 35 U.S.C. § 103(a) as being unpatentable over *Levine*. The Office Action rejects Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over *Levine* in view of U.S. Patent No. 5,636,324 to Teh et al. (“*Teh*”). The Office Action rejects Claim 13 under 35 U.S.C. § 103(a) as being unpatentable over *Levine* in view of U.S. Patent Publication No. 2002/0116199 to Wu et al. (“*Wu*”). The Office Action rejects Claims 14-17 under 35 U.S.C. § 103(a) as being unpatentable over *Levine* in view of “applicant’s acknowledged prior art.” The Office Action rejects Claims 19 and 26 under 35 U.S.C. § 103(a) as being unpatentable over *Levine*

in view of U.S. Patent No. 5,285,498 to Johnston ("*Johnston*"). The Office Action rejects Claims 20-24 under 35 U.S.C. § 103(a) as being unpatentable over *Johnston* in view of *Levine*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP* § 2142).

As described above in Section III, Claims 1 and 25 are patentable. As a result, Claims 2, 4, 13-17, 19, and 26 are patentable due to their dependence from allowable base claims.

Regarding Claims 20-24, *Johnston* recites a mechanism for coding stereo audio signals. (*Abstract*). An audio coder used to encode the audio signals includes a quantizer and rate loop processor. (*Figures 1 and 2*). Among other functions, the rate loop processor inserts "synchronization and framing information." (*Col. 7, Lines 50-55*).

Claims 20, 21, and 23 all recite receiving a "modeled modified signal" containing "side information describing an original time difference between corresponding transients." The cited portion of *Johnston* merely states that "synchronization and framing information" are inserted into encoded stereo signals. The cited portion of *Johnston* lacks any mention that the "synchronization and framing information" includes an "original time difference between corresponding transients" as recited in Claims 20, 21, and 23.

*Levine* is not cited by the Office Action as disclosing, teaching, or suggesting these elements of Claims 20, 21, and 23. As a result, the Office Action fails to establish that the proposed *Johnston-Levine* combination discloses, teaches, or suggests these elements of Claims 20, 21, and 23 (and their dependent claims).

For these reasons, the Office Action fails to establish a *prima facie* case of obviousness

against Claims 2, 4, 13-17, 19-24, and 26. Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 2, 4, 13-17, 19-24, and 26.

V. **CONCLUSION**

As a result of the foregoing, the Applicants assert that the remaining claims in the application are in condition for allowance and respectfully request an early allowance of such claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

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